

REMARKS

Applicant amends claims 1, 8, 10, 19, and 20 to more clearly define the features of those claims.

Claims 1-20 are currently pending.

In the Office Action, the Examiner rejected claims 1-20 under 35 U.S.C. § 103(a) as unpatentable over International Publication No. WO 02/073933 to Hovell et al. (Hovell) in view of U.S. Patent Application Publication No. 2004/0107287 to Ananda et al. (Ananda). Applicant respectfully traverses this rejection.

Claim 1 defines an apparatus comprising:

a resolver configured to perform name resolving;

a first connector configured to provide a first direct connection to a first network, using a first network protocol;

a second connector configured to provide a second direct connection to a second network using a second network protocol, wherein, when the resolver in the first network forwards a name resolving request to a domain name service server in the second network, the name resolving request is sent directly from the resolver in the first network to the second network without using a network address translator server configured to process packets other than the name resolving request sent to the second network; and

a translator configured to perform address translation between the first network and the second network, the translator, separate from the network address translator server, performing address translation on the name resolving request sent directly to the second network without using the network address translator server;

wherein the resolver and the translator are configured to co-operate in order to translate addresses upon performing name resolving, and *wherein the resolver and the translator are configured on the same domain name server for resolving the name resolving request rather than data traffic corresponding to the packets other than the name resolving request and occurring after the name resolving is performed.*

Emphasis added.

The Examiner commits a clear error by ignoring the express language of claim 1 which states: *"wherein the resolver and the translator are configured on the same domain name server for resolving the name resolving request rather than data traffic corresponding to the packets other than the name resolving request and occurring after the name resolving is performed."* Emphasis added. Specifically, at pages 11 and 12 of the Final Office Action, the Examiner alleges that Ananda's network 225 constitutes an apparatus in which the "the resolver and the translator are configured on the same domain name server for resolving the name resolving request." In response to Applicant's response filed July 27, 2009, the Examiner states:

In response to the preceding arguments examiner respectfully submits that Ananda teaches **"wherein the resolver and the translator are configured on the same domain name server"** as reference numeral 225 (Ananda Figure 2).

In figure 2 shown above examiner interprets the gateway multi-protocol subnet 225, which contains dual stack DNS and CPI 225C together as a whole as enhanced DNS of the applicant because the gateway multi-protocol subnet 225 provides the direct connections to IPv4 and IPv6 networks and also this gateway 225 as a whole provides the name resolving and address translation.

Final Office Action, pages 11-12.

However, the Examiner's position flies in the face of logic and the express disclosure of Ananda. First, the subnet 225 cannot possibly constitute a domain name server, much less one "wherein the resolver and the translator are configured on the **same** domain name server" (emphasis added). The language of claim 1 clearly

requires a single apparatus, namely the same domain name server, to include a resolver and a translator.. To make exceedingly clear that the Examiner has committed a clear error in this instance, Applicant has further amended claim 1 to recite that “the same domain name server [is] for resolving the name resolving request rather than data traffic corresponding to the packets other than the name resolving request and occurring after the name resolving is performed.”

Moreover, Applicant fails to see how four things, namely subnetwork 225 including the IPv4/IPv6 DNS server 225A, an IPv4 Router 225B, and a Gateway Communications Protocol Interface 225C, can be alleged to constitute the apparatus recited in claim 1 “wherein the resolver and the translator are configured on the same domain name server” as recited in claim 1. As required by 35 U.S.C. §132, Applicant requests the Examiner to provide remarks to shed light on how four things can be squashed into one thing.

Because Ananda fails to disclose a single domain name sever which includes a resolver and a translator used for the initial name resolving requests rather than the subsequent traffic after name resolution, Ananda fails to disclose or suggest at least the following features of claim 1: “wherein the resolver and the translator are configured to co-operate in order to translate addresses upon performing name resolving, and wherein the resolver and the translator are configured on the same domain name server for resolving the name resolving request rather than data traffic corresponding to the packets other than the name resolving request and occurring after the name resolving is performed.”

Furthermore, the Examiner admits on page 4 of the Final Office Action that Hovell fails to disclose this noted feature.

In view of the foregoing, neither Hovell nor Ananda discloses or suggests this above-noted feature of claim 1. Therefore, claim 1 and claims 2-7, at least by reason of their dependency from independent claim 1, are allowable over Hovell and Ananda, whether those references are taken alone or in combination, and the rejection under 35 U.S.C. § 103(a) of those claims should be withdrawn.

Independent claims 8, 10, 19, and 20, although of different scope, include one or more features similar to those noted above with respect to claim 1. For at least the reasons given above with respect to claim 1, claims 8, 10, 19 and 20, as well as claims 9 and 11-18, at least by reason of their dependency from independent claims 8, 10, and 19, are allowable over Hovell and Ananda, whether those references are taken alone or in combination, and the rejection under 35 U.S.C. § 103(a) of those claims should be withdrawn.

Regarding the motivation to combine, the Examiner's modifications to Ananda fundamentally change the principal of operation of Ananda. Specifically, the Examiner reconstruction of Ananda fundamentally changes the subnet 225 as well as the IPv4/IPv6 DNS server 225A, the IPv4 Router 225B, and the Gateway Communications Protocol Interface 225C so that they are literally squashed into a single operative device. This was clearly not contemplated by Ananda. Furthermore, Applicant doubts that Ananda would be operative given the fundamental modifications proposed by the Examiner. Thus, the Examiner's modifications of Ananda run afoul of M.P.E.P 2143.03 which states "[i]f the proposed modification or combination of the prior art would change


the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).” Therefore, the rejection under 35 U.S.C. § 103(a) of claim 1-20 should be withdrawn for this additional reason.

CONCLUSION

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Applicant asks that all claims be allowed.

No fees are believed to be due, however the Commissioner is authorized to charge any fees or credit overpayments to Deposit Account No. 50-0311, reference No. 39700-501001US/NC31574US. If there are any questions regarding this reply, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Respectfully submitted,



Pedro F. Suarez
Reg. No. 45,895

Date: 4 February 2010

Address all written correspondence to:
Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.
3580 Carmel Mountain Road, Suite 300
San Diego, CA 92130
Customer No. 64046
Phone: (858) 314-1540
Fax: (858) 314-1501